

REMARKS

Applicant has carefully reviewed the Office Action of November 18, 2003 and offers the following remarks in response thereto. Applicant appreciates the telephone interview of January 12, 2004, at which time some of these points were discussed. Where appropriate, the comments therefrom are incorporated herein.

Initially, claims 1-3, 5, 7-11, 13-16, 18-20, 22, 24-28, and 30-33 were rejected under 35 U.S.C. § 101 for not reciting a limitation in the technological arts.

Applicant herein amends claim 1 to recite a structural component, namely that the request originates in a telephony device, which places the method of claim 1 and its dependents squarely within the technological arts. Applicant requests withdrawal of the § 101 rejection at this time.

With respect to claims 18-20, 22, 24-28, and 30-33, Applicant respectfully traverses. The Patent Office's rejection suggests that the system may be understood as merely two people talking over the phone and thus does not provide any technical limitations. The Patent Office apparently has overlooked the "control system" element of claim 18. A control system connotes a component within the technological arts. Further, the presence of the phone over which the people are communicating (a phone being an article of manufacture within the technological arts) also helps bring this claim into the realm of the technological arts. While Applicant appreciates the Examiner's concerns that a "control system" is very broad, broadness of a structural element is not a basis to consider something outside the technological arts. Applicant has complied with the requirements of 35 U.S.C. § 101 and requests that the § 101 rejection of these claims be withdrawn.

Claims 18-20, 22, 24-28, 30-33, 49 and 50 were rejected under 35 U.S.C. § 112 as being indefinite.

Applicant herein amends claims 22, 49 and 50 to have the proper dependencies. No new matter is added by this amendment, and Applicant requests withdrawal of the rejection at this time with respect to these claims.

With respect to claim 18, this rejection stems from the Patent Office overlooking the control system in the body of the claim. Specifically, the control system appears after the transition word "comprising" which, by the tenets of claim interpretation, indicates that the element is in the body of the claim and thus has patentable weight. The control system component of the system is adapted to perform the method steps. As such, the claim is a system

claim, with method components. However, it remains a system claim and is not indefinite. Placing method elements in system claims is common claim drafting practice and no indefiniteness is created thereby. Applicant requests withdrawal of the § 112 rejection of these claims at this time.

Before addressing the rejection based on the reference, a brief summary of the present invention and a brief review of the Jain reference are provided so that the remarks are provided their proper context.

The present invention is designed to facilitate toll sharing amongst call participants who are using telephony devices. Specifically, the present invention allows a call originator, with whom responsibility for paying the toll charges of the call normally resides, to request a toll sharing function. This request may be initiated through a command code or through the operator. Once the request is received, the present invention allows the call originator to define proposed toll sharing parameters. These proposed toll sharing parameters are presented to the call recipient as part of the call set up process. The call recipient may accept or decline the toll sharing parameters. If accepted, the parties are billed according to the toll sharing arrangement. Additionally, the present invention allows the toll sharing parameters to be part of an ongoing relationship, such that once the toll sharing parameters are agreed to, future calls between the parties are also subject to the toll sharing arrangements.

Jain et al., hereinafter "Jain," is a reference that is used by a single user to allocate how calls are billed amongst a variety of accounts all associated with the single user. That is, a single user may have multiple accounts and may want to allocate specific calls to specific accounts for billing purposes. See col. 3, lines 11-20. To this end, the single user may, on a per-call basis, indicate to which account a particular call is to be billed. This may be done for both incoming and outgoing calls.

Claims 1-3, 5, 7-11, 13, 15, 16, 18-20, 22, 24-28, 30, 32, 33, 35-37, 39, 41-45, 47, and 49-51 were rejected under 35 U.S.C. § 103 as being unpatentable over Jain. Applicant respectfully traverses. For the Patent Office to establish *prima facie* obviousness, the Patent Office must show where each and every claim element is located in the reference. MPEP § 2143.03. Merely because a modification *could* be implemented, does not establish a *prima facie* case of obviousness. MPEP § 2143.01. Furthermore, where a reference must be modified to show all the claim elements, the Patent Office must present objective evidence as to where the

suggestion to modify the reference can be found. *In re Dembiczak*, 175 F.3d 994, 999 (Fed. Cir. 1999).

Claims 1, 18, and 35 (the independent claims) recite some permutation of "receive a request for *toll sharing* from a call initiator ordinarily responsible for paying a toll associated with a toll call" The Patent Office opines that this element can be found in at col. 4, lines 1-7, 17-25 and col. 9, lines 31-45 of Jain. Applicant respectfully traverses this assertion. The first passage states:

Personal Billing Selection, enables a communications network service subscriber to designate options for allocating network usage for outgoing and incoming calls on a per-call basis, even if the subscriber's account includes several numbers or addresses. The present invention also preferably allows users to designate default network resource allocation accounts on a per-number dialed or received basis.

While the Patent Office is allowed to give claim terms a broad reasonable interpretation in the absence of a definition in the specification, that interpretation is constructed from the perspective of someone of ordinary skill in the art. MPEP § 2111. Further, claim terms are to be given their ordinary meaning. MPEP § 2111.01. The claim recites "*toll sharing*" and sharing implies a split between two parties. For example, the definition at www.m-w.com indicates that to "*share*" is to divide or distribute (a copy of the print out from www.m-w.com attached for convenience). In light of this ordinary definition, it is readily apparent that Jain describes allocating the toll to an account, but does not *share* the toll amongst accounts or between parties. To this extent, the cited passage does not teach the claim element. Col. 4, lines 17-25 recites:

A predefined default billing (or other network resource allocation) preference designators can be specified for both originated and received calls. A default billing preference designator may also be provided for unspecified numbers or addresses. The allocation designation may be provided to a network database which handles network resource allocation, such as billing, so that the network allocation is associated with the particular communication.

Again, this passage talks about allocating the toll to an account, but does not discuss sharing the toll amongst accounts or between parties. To this extent, the cited passage does not teach the claim element. The final passage talks about how call tolls are allocated to a specified account; however, there is no "*sharing*" as that term is ordinarily used or under any reasonable broad definition of the term "*sharing*." To this extent, the cited passage does not teach the claim

element. Since the passages do not teach or suggest this claim element, the Patent Office has not established *prima facie* obviousness and the claims are allowable.

The claims also recite "receiving proposed toll sharing parameters" The Patent Office cites the same passages from Jain. Applicant respectfully traverses this assertion. The cited passages allocate tolls to accounts, but do not teach or suggest toll sharing. Since the passages do not teach or suggest this element, the Patent Office has not established *prima facie* obviousness and the claims are allowable.

The Patent Office indicates, in its analysis of claims 1, 18, and 35, that "querying [sic] the recipient database for obtaining the default billing preferences" is taught at col. 9, lines ~~45~~³⁵-49. The claims do not recite such an element, and the fact that the reference may or may not teach such an element is not relevant. However, this passage shows that the tolls are allocated by the call initiator to accounts for which the call initiator is responsible, not "shared" as that term is used.

During the telephonic interview, the Examiner clarified that under a broad interpretation of "sharing", one person could remain responsible for the entire cost of the call. If that single person was the call initiator, then in such an instance, the cost of the call would be "allocated" to a single account as shown in Jain. Applicant respectfully maintains that such an interpretation of "sharing" is not within an ordinary reasonable interpretation. A person cannot assume 100% of the cost of something and still share the cost with another person. The reference does not show a reasonable interpretation of sharing, because, as explained above, the call initiator in Jain remains liable for 100% of the cost of the call. To this extent, the Patent Office's interpretation of sharing is clearly beyond that considered reasonable by someone of ordinary skill in the art.

Applicant further respectfully maintains that no one of ordinary skill in the art would come to the claimed invention under the Patent Office's construction of the term "sharing." Under the Patent Office's construction, the call initiator is assuming responsibility for 100% of the cost of the call. In a conventional billing arrangement, the call initiator is responsible for 100% of the cost of the call. Thus, if the call initiator wished to maintain this conventional billing arrangement, the call initiator would never request toll sharing and nothing would receive the proposed toll sharing parameters. Since nothing would receive the proposed toll sharing parameters, the call recipient would never be informed of the proposed toll sharing parameters. Since the call recipient would never be informed of the proposed toll sharing parameters, nothing

would receive a decision from the call recipient as to whether the toll sharing parameters were accepted. Specifically, there is no reason why a call initiator would create a situation where the call recipient received an inquiry along the lines of "I am calling you, do you mind if I pay for the call?" Even if the Patent Office's interpretation of the term "sharing" is correct, there is still no teaching in Jain that suggests that such a communication is sent. Specifically, if, as indicated by the Patent Office, the term "sharing" contemplates the caller assuming 100% of the cost of the call, then the claim still recites that the call recipient be asked if this toll sharing situation is acceptable. Since Jain does not teach or suggest that the call recipient is ever informed of the call cost allocation disclosed in Jain, the claim element is not taught or suggested by Jain. Further, since the reference does not teach or suggest informing the call recipient of the proposed toll sharing parameters, the reference cannot teach or suggest receiving a decision from the call recipient as to whether the toll sharing parameters are accepted. Specifically, Jain does not teach or suggest a communication passing to the call recipient, inquiring as to whether the call recipient accepts the toll of the call being allocated to a specific account for which the call initiator is entirely responsible. To this extent, the reference does not teach or suggest two additional claim elements, and the reference does not establish *prima facie* obviousness.

Finally, the Patent Office opines that the reference teaches "apportioning the costs for the toll call between the call initiator and the call recipient" at col. 9, lines 31-49. Applicant respectfully traverses this assertion. The cited passage does not teach Applicant's intended toll sharing as explained above. While the passage indicates that the toll is assigned to an account as indicated in a database, there is no apportionment of the toll between the two parties and thus, the claim element is not taught or suggested.

The Patent Office indicates that it would have been obvious to modify Jain "to include that obtaining the recipient's default billing preferences includes obtaining a decision from the call recipient as to whether to accept the toll sharing parameters, because it appears that the claimed features do not distinguish the invention over similar features in the prior art, and the teachings of Jain would perform the invention as claimed by the applicant with either specifying recipient's decision, or not." Applicant respectfully traverses this assertion. The Patent Office misunderstands the toll sharing of the claimed invention relative to the toll allocation from amongst the various accounts of the reference. The reference has a single person solely responsible for the tolls of the call. That person may allocate the toll to a desired account, but

there is nothing in the reference that teaches or suggests that the tolls may be shared between two parties, much less shared between two parties after informing the call recipient of the proposed toll sharing parameters and receiving the decision of the call recipient as recited in the claims. Even if the Patent Office's interpretation of sharing explained during the telephonic interview were correct, the default billing designators of Jain are still internal to the call initiator. The call recipient never has an opportunity to be informed of how Jain's call initiator is going to allocate the call, nor does the call recipient have the opportunity to accept such an allocation of costs, much less provide the recipient's default billing preferences. To this extent, the claim element is not shown, and the Patent Office has not established *prima facie* obviousness for the claims with this element.

Applicant provides new claims 54-56 that explicitly recite that the call initiator and the call recipient both bear the costs of the call. As numerous dependent claims have previously been canceled and only three claims are added, no new fees should be required. While Applicant believes that the term "sharing" implies that both the call initiator and the call recipient bear a non-zero portion of the costs of the toll call, these claims make it explicit. Jain, with its single party cost allocation, clearly does not teach or suggest the sharing of the call such that both parties bear a non-zero portion of the costs of the toll call.

In short, the reference does not teach or suggest the toll sharing of the claimed invention. This element is present in each of the independent claims and is present in each of the dependent claims. Since the reference does not teach or suggest the claim element, the Patent Office has not established *prima facie* obviousness. Applicant earnestly solicits claim allowance at the Examiner's earliest convenience.

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Respectfully submitted,

WITHROW & TERRANOVA, P.L.L.C.

By:

[Signature]
Benjamin S. Withrow
Registration No. 40,876
P.O. Box 1287
Cary, NC 27512
Telephone: (919) 654-4520